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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/649,473
Filing Date: 8/28/00
Appellant(s): MCCARTY ET AL.

William M. Hanlon, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/22/03.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 6, 9, 10, 11, 12, and 13 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Claims 5 and 8 stand or fall with claim 1.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

1,505,609	Seeman et al.	8-1924
659,524	Ghezzi et al.	10-1900
2,199,505	Lo	7-1988

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghezzi et al. (Ghezzi). This rejection is set forth in prior Office Action, Paper No. 17.

Claims 1, 10, 11, 12, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Seeman et al. (Seeman). This rejection is set forth in prior Office Action, Paper No. 17.

Claim 13 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lo. This rejection is set forth in prior Office Action, Paper No. 17.

Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ghezzi. This rejection is set forth in prior Office Action, Paper No. 17.

Claims 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghezzi. This rejection is set forth in prior Office Action, Paper No. 17. Regarding claims 6 and 9, Ghezzi does not disclose the exact length of his bore though it appears to be on the order of 4 to 5 inches. The exact length would obviously have been up to the ordinarily skilled artisan depending on the amount of length that one felt was necessary to properly retain the tip element absent some showing of unexpected

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results. Just as in appellant's claimed device the removal of material from the tip end will lighten that portion of the cue.

(11) Response to Argument

In response to appellant's claim 1 argument pertaining to Ghezzi the examiner's response remains the same as it has been. The portion of Ghezzi's tip fastening means 14, 15 which projects into the void space is the same structure as applicant's element 16 which projects into the void space (Note appellant's Fig. 3), and thus Ghezzi meets the terms of the claims as appellant has defined them.

Regarding appellant's claim 1 argument pertaining to Seeman, Seeman clearly shows the void bore at the tip end of the cue as shown in Fig. 2. What other portions of Seeman's cue are hollow is irrelevant. Appellant has freely admitted on page 4, lines 22 and 23, that Seeman's cue is "essentially hollow from one end to the other". This means that applicant sees the cue as being hollow from the tip end. As can be clearly seen in Fig. 2 of Seeman the hollow portion at the tip end terminates at the joint structure. Again it is noted that appellant has placed no limits on what is considered the "tip end" or "proximity with the tip end". Claim 10 teaches us that the bore may extend "at least 10 to 12 inches" from the tip end yet still be in "proximity with the tip end". It should also be noted that the tip of a cue stick and the "tip end" are not one and the same. The "tip" is a definable point on the cue whereas the tip end refers to an area closer to the tip than the butt.

Appellant's claim 10 argument adds nothing further. The claim only requires that the bore extend "at least 10 to 12 inches" from the tip end. No upper limit on the bore has been established.

Appellant's claim 13 argument does not differ from the analysis addressed above. Seeman's bore clearly extends "from the tip end for at least a predetermined distance along the length of the shaft toward the opposed end" as required. Though the tip end bore terminates at the cue joint it would not matter if it did extend the entire length of the cue as asserted by appellant. Appellant has placed no limit on the length of the bore.

The claim 13 argument over the Ghezzi rejection is no more persuasive. The examiner has not used appellant's application against him. The examiner has merely interpreted appellant's claims in light of his specification to obtain an accurate understanding of the subject matter which appellant is claiming. Such an interpretation clearly indicates that the claim limitations pertaining to the nature of material in the bore are at least inclusive of the fastening portion of the tip as can be seen in appellant's Fig. 3. If appellant's definition of a bore devoid of material is inclusive of the tip fastening means then the prior art must be read that way as well.

As to the examiner's "unsupported opinion" the examiner has looked at the relative volume of Ghezzi's element 14, 15 and compared it with the volume of the material surrounding the bore as it is shown in Fig. 2 of Ghezzi. Clearly the amount of material surrounding the bore is of much greater volume than element 14, and 15 and any ordinarily skilled artisan would recognize that unless the cue was made of some

material of an unexplainably low mass and the element was made of some material of an unexplainably high mass the claim limitation would be met. The examiner cannot conjure any scenario where such a relationship would occur and thus has offered a reasonable opinion as to the nature of Ghezzi's cue tip end as it relates to what has been claimed.

Moreover, if the bore is considered the bore within ferrule 23 in Ghezzi's Fig. 8 embodiment even more weight will be added to the shaft portion surrounding the bore.

Regarding the Lo argument, it is again pointed out that claim 13 places no limit on the length of the bore and Lo's foam extends the entire length of the bore save for the portion of the tip fastening means at the end of the bore just as with appellant's cue.

Appellant next argues the claim 12 rejections based on Seeman and Ghezzi. The arguments presented merely repeat those previously advanced with regard to the two references and thus the examiner's response is the same as above. Both Seeman and Ghezzi contain air which provides no structural support and Ghezzi also provides element 14, 15 which provides no structural support.

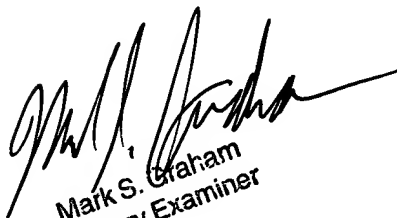
The final argument presented concerns claims 6 and 9. Appellant asserts that Ghezzi does not recognize the advantages of removing material from the tip end. However, it is not required that the prior art structure be made for the same reason as the claimed structure. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991).

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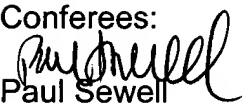
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham


Mark S. Graham
Primary Examiner

MSG
October 24, 2003

Conferees:

Paul Sewell


Steve Wong